

Serial No. 09/837,183
Response to Office Action mailed September 30, 2002
Page 3

REMARKS

In the Office Action, claims 1-21 were rejected. By the present Response, claims 1, 10 and 17 have been amended for the purposes of clarification. Accordingly, claims 1-21 remain pending. Reconsideration and allowance are respectfully requested.

Rejections under 35 U.S.C. §102

In the Office Action, the Examiner rejected claims 1-21 under 35 U.S.C. §102(b) as being anticipated by Kimble (US 4,781,422). A *prima facie* case of anticipation under 35 U.S.C. § 102 requires a showing that each limitation of a claim is found in a single reference, practice or device. *In re Donohue*, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Applicant respectfully asserts that the pending claims contain features not disclosed in the cited reference. With respect to these claims, the Examiner, in the Office Action, stated that, "Kimble disclose[s] (Fig. 1-3) a computer system (10) comprising ... a mechanically actuated operator (75, 85), the operator (75, 85) being operable to remove at least a portion of the force preventing the display enclosure (14-16) from pivoting." *See* Paper 2, page 2 (parentheticals in original). Applicant respectfully asserts the cited reference does not disclose a mechanically actuated operator as the Examiner contends.

In contrast to the Examiner's contention, the cited reference merely discloses a bolt 75 that must be *manually tightened* thereby creating sufficient friction between the rings 34 and 35 to cause the terminal top 14 to remain at a location desired by the user. *See* Kimble '422, column 4, lines 21-28. There is no suggestion in the cited reference to support the conclusion that the bolt is *mechanically actuated*. Rather, the cited reference explicitly states that the bolt 75 is, "screwed into the tapped opening 81, caus[ing] the bolt head 85 and plate 82 to move toward each other." *See id.*, column 4, lines 11-12 (emphasis added). As such, the cited reference makes clear that the bolt 75 and bolt head 85 are *manually tightened* and not *mechanically actuated* as the Examiner contends.

Serial No. 09/837,183
Response to Office Action mailed September 30, 2002
Page 4

Applicant respectfully asserts the Examiner, by his contention, has read elements into the cited reference that are not disclosed therein.

Beginning with claim 1, this claim recites, "a selectively actuated operator, the operator being operable to remove at least a portion of the force preventing the display enclosure from pivoting." Applicant respectfully asserts that the cited reference does not disclose a "selectively actuated operator" as recited in the instant claim. Rather, the cited reference discloses a bolt 75 that is tightened during the assembly process so as to obtain the desired frictional forces between the rings 34 and 54. *See* Kimble '422, column 4, lines 3-28. In other words, the frictional force is removed only by manually *disassembling* the bolt 75 assembly. As such, one would not be able to "select" actuation of the operator as recited in the instant claim. Accordingly, the bolt 75 assembly of the cited reference is not "selectively actuatable" as recited in the instant claim.

Additionally, the cited reference does not disclose an "operator being operable" as recited in the instant claim. As argued above, the cited reference discloses a bolt that is tightened in the assembly process so as to obtain the desired frictional forces between the rings 34 and 54. Applicant again respectfully asserts the frictional force of the cited reference is removed by *disassembly* of the bolt 75 assembly. Accordingly, the bolt assembly would be not "*operable*" as recited in the instant claims.

For the above reasons, Applicant respectfully asserts that independent claim 1 and its respective dependent claims 2-9 are patentable over the cited reference. Reconsideration and allowance are respectfully requested.

Turning next to independent claim 10, this claim recites, "a third portion manually actuatable to prevent the second portion from opposing pivotal motion of the display." As discussed above, the cited reference does not disclose a "manually actuatable" portion. Rather, the cited reference discloses a bolt 75 and bolt head 85 that are tightened to

Serial No. 09/837,183
Response to Office Action mailed September 30, 2002
Page 5

achieve the desired frictional force. Once the appropriate force level is achieved, the force applied is neither increased nor reduced during operation. Moreover, as also discussed above, it is only during the *disassembly* of the bolt 75 structure will the friction between the rings 34 and 54 be reduced. Accordingly, the cited reference fails to disclose at least one of the features recited in the instant claim. Thus, independent claim 10 and its respective dependent claims 11-16 are patentable over the cited reference combination. Reconsideration and allowance are respectfully requested.

With respect to claims 17-21, the Examiner stated that, “[t]he method steps recited in the claims are necessitated by the device structure as disclosed by Kimble.” *See* Paper 2, page 4. Applicant respectfully asserts that the cited reference does not disclose all of the features recited in the instant claim.

Applicant respectfully asserts that the cited reference does not disclose, “selectively actuating a clutch assembly to reduce a force opposing pivotal motion of the display,” as recited in the instant claim. Rather, the cited reference merely discloses a bolt 75 that must be manually tightened. Moreover, the reduction in force can only be achieved, as discussed above, by *disassembly* of the bolt 75 and the rings 35 and 54. Accordingly, the cited reference fails to disclose at least two of the features recited in the instant claim. Thus, independent claim 17 and its respective dependent claims 18-21 are patentable over the cited reference combination. Reconsideration and allowance are respectfully requested.

Regarding claims 4, 7 and 11, the Examiner stated that:

[T]he functional recitation of claim 4 that said “operator prevents the force producer from driving the first and second member into contact”, the functional recitation of claim 7 that said “operator is electrically actuated”, and the functional recitation of claim 11, that said “third portion is electrically operated” has not been given patentable weight because these recitations are

Serial No. 09/837,183
Response to Office Action mailed September 30, 2002
Page 6

narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 USC §112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

See Paper 2, page 3 (emphasis in original). Applicant respectfully disagrees with the Examiner's contention.

From the Examiner's foregoing statement, it appears the Examiner's contends the instant claims lack sufficient structure and, as such, must be construed as means-plus-function claims that are governed by 35 U.S.C. §112, sixth paragraph. In contrast to the Examiner's contention, Applicant respectfully asserts that the above claims contain. Additionally, functional language has been recognized as acceptable in structural claims. *See* M.P.E.P. §2173.05(g).

Applicants would like to begin by noting that claims 4, 7 and 11 are dependent claims that depend from independent claims 1 and 10 respectively. As such, the instant claims include the recitations of each claim's respective independent claim. Thus, the recitations of the instant claims must not be read in a vacuum, but rather, the claims should be interpreted in light of the respective independent claim from which they depend. When read in this light, it can be clearly seen that the instant recitations of claims 4, 7 and 11 respectively serve to precisely define present structural attributes of interrelated component parts of the claimed assembly.

Even assuming, *arguendo*, that the Examiner's assertion that claims 4, 7 and 11 recite functional language is true, the fact that the claims may recite functional language is not reason alone to ignore the recitation. The M.P.E.P. states, "[t]here is nothing inherently wrong with defining some part of the invention in functional terms." M.P.E.P. §2173.05(g). A functional limitation must be evaluated and considered, just like any

Serial No. 09/837,183

Response to Office Action mailed September 30, 2002

Page 7

other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. *See id.* In the instant case, the limitations recited in claims 4, 7 and 11, in light of each claim's respective independent claim, serve to precisely define present structural attributes of interrelated component parts of the claimed assembly.

Regarding claims 12 and 13, the Examiner stated that:

Kimble disclosed a biased (by spring (80) (sic) fourth position (85), the fourth position being manually operable. The functional recitation of claim 12 "to control electrical power to the third portion" and the functional recitation of claim 13 "so as to not supply power to the third portion" has not been given patentable weight because the recitations are narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function as set forth in 35 U.S.C. §112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

See Paper 2, page 4 (emphasis in original). Applicant respectfully disagrees with the Examiner's contention.

Applicant would like to begin by noting that claims 12 and 13 are dependent claims based upon independent claim 10. Similar to the discussion above, Applicant respectfully reiterates that claims 12 and 13 must not be read in a vacuum, but rather, in light of the independent claim from which they depend. In such light, it can be clearly seen that claims 12 and 13 recite features that serve to precisely define present *structural* attributes of the interrelated component parts of the claimed assembly.

Serial No. 09/837,183
Response to Office Action mailed September 30, 2002
Page 8

Additionally, even assuming, *arguendo*, the Examiner is correct in his assertion that the instant claims are contain functional recitations, the mere fact that the Examiner has labeled the recitations as such is not sufficient reason to ignore the recitations. *See* M.P.E.P. §2173.05(g). Thus, Applicant respectfully asserts that the recitations claims 12 and 13 should not be ignored. Reconsideration and allowance are respectfully requested.

Attachment

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

Conclusion

In view of the above remarks and amendments set forth above, Applicant respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Date: December 30, 2002

Respectfully submitted



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Serial No. 09/837,183
Response to Office Action mailed September 30, 2002
Page 9

VERSION WITH MARKINGS TO SHOW CHANGES MADE

Please amend the application as follows:

IN THE CLAIMS

Please amend claims 1, 10, and 17 as follows:

1. (Amended) A computer system, comprising:
 - a base;
 - a display enclosure housing a display; and
 - a securing mechanism to pivotably secure the display enclosure to the base, comprising:
 - a positioning assembly that produces a force to prevent the display enclosure from pivoting; and
 - ~~an a selectively actuated operator, the operator being operable to remove at least a portion of the force preventing the display enclosure from pivoting.~~

10. (Amended) A clutch assembly for pivotably securing a computer display to a computer base, comprising:
 - a first portion to enable the computer display to pivot relative to the computer base unit;
 - a second portion to produce a force to oppose pivotal motion of the display; and
 - a third portion ~~manually actuatable~~ operable to prevent the second portion from opposing pivotal motion of the display.

Serial No. 09/837,183
Response to Office Action mailed September 30, 2002
Page 10

17. A method of operating a computer system having a base unit and a pivotable display, comprising:

selectively actuating ~~operating~~ a clutch assembly to reduce a force opposing pivotal motion of the display; and
pivoting the display.

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